

**REMARKS**

The Office Action of July 16, 2003 has been received and considered. In the Office Action, claim 9 was indicated to be allowable if rewritten in independent form. Also, claims 1-8 and 10-11 were rejected over various publications.

Claims 1 and 4-7 have been amended. Claims 10 and 11 have been cancelled. Claims 1-9 remain pending. Reconsideration of the application is requested.

In the outstanding Office Action, claims 1 to 11 were rejected under the doctrine of obviousness-type double patenting. The Applicants have provided a terminal disclaimer to address this rejection. Withdrawal of the rejection is requested.

Claims 1 to 9 were rejected under 35 U.S.C. § 112, second paragraph. The Examiner is kindly thanked for noting portions of the claims that are not believed to comply with 35 U.S.C. § 112. Revisions have been made to the claims noted in the Office Action to overcome these objections. Withdrawal of the rejections under 35 U.S.C. § 112 is requested. In addition, a grammatical error has been corrected in claim 1.

The Examiner is kindly thanked for the allowance of claim 9, if rewritten in independent form, including all the limitations of the base claim and any intervening claims.

Claims 1 to 8 have been rejected under 35 U.S.C. § 103 as being unpatentable over WO 95/34226 to Kijowski in view of various other publications.

The Office Action includes a section that summarizes the disclosure of Kijowski as it is understood by the USPTO. Applicants submit however that based upon a fair reading of Kijowski, this reference does not teach all that is asserted in the Office Action. For example, Kijowski does not teach an open end for the tubular element when the tobacco charge is burning. Instead, it requires either a cap or other sealed end for the tubular element while the tobacco charge is burning (see page 4, line 9 to page 5, line 5). A tubular element having a cap over its end or a fiberous material filling its end cannot fairly be considered a tube with an open end. Conversely, the

tubular element of the Applicants' invention has an open end that provides for free air flow into the tube to ensure that sufficient air is freely drawn into the tubular element and through the cigarette as mainstream smoke. The open end of the recited tube ensures unrestricted flow of air to the cigarette when the smoker draws on the cigarette as the tobacco is burning. In addition, Kijowski does not define a porosity for the tubular element that minimizes sidestream smoke emission from a burning tobacco charge and reduces free-burn rate of the burning tobacco charge to increase the number of puffs from the burning tobacco charge. Furthermore, Applicants agree with the statement in the Office Action that Kijowski does not teach or suggest the filter tip of the claimed invention.

Kijowski does not teach or suggest the combination recited in claim 1 because claim 1 differs from this reference in at least three important areas: (1) the recited tubular element has an open end when the cigarette is being smoked; (2) the predetermined porosity that (a) reduces the free-burn rate of the burning tobacco charge to increase the number of puffs from a burning tobacco charge, an inherent advantage of the Applicants' claimed system, not found in Kijowski, and (b) minimizes sidestream smoke emission from a burning tobacco charge; and (3) the recited filter tip. Therefore, claim 1 and claims dependent therefrom are patentable over this reference.

Although it is stated in the Office Action that Kijowski does not teach having the filter tip of the claimed invention, the Office Action has identified three other references (Ferka, Romano and Di Rubbio) that, as understood by the USPTO, teach the filter tip. As discussed above, the Applicants submit that Kijowski does not teach or suggest the tubular element or the filter tip of the claimed invention. In addition, the Applicants submit that Ferka, Romano and Di Rubbio, singly or in combination, do not teach the filter tip of the claimed invention. Moreover, Ferka, Romano and Di Rubbio and Kijowski do not teach or suggest the combination of the recited tubular element and the filter tip. Therefore, Kijowski, in combination with any or all of these references, does not teach the claimed invention. As a result, the combinations

asserted in the Office Action would not have been obvious to one of ordinary skill in the art.

More particularly, with respect to Ferka, the Office Action suggests that it would have been obvious to add a tubular filter to the filter of Ferka. In fact, Ferka teaches away from using a filter material, for instance, at column 1, lines 19 to 27, it is described that filters detract from the enjoyment of cigarette smoking. Furthermore, Ferka does not make any provisions for a downstream filter nor a plenum between cylindrical filters and the downstream filter. Therefore, the teachings of Ferka would not have motivated one of ordinary skill in the art to make the modification suggested in the Office Action.

With respect to Romano, the Office Action suggests that the filter of Romano may be simply reversed to provide the filter tip of claim , however it is not that easy. In the Applicants' claimed system, the inner filter is the primary filter. By reversing Romano, the smoke would have to pass through the funnel with a restricted tube. This would greatly impact on mainstream drag resistance. Furthermore, Romano does not make any provisions for a downstream filter nor a plenum between the cylindrical filters and the downstream filter. Therefore, the teachings of Ferka would not have motivated one of ordinary skill in the art to make the modifications suggested in the Office Action.

It is submitted, therefore, that it would not be obvious to combine the teachings of Ferka and Romano with Kijowski and for that matter to rely on Di Rubbio's use of a filter plug downstream of the filter. Withdrawal of the rejections set forth in the Office Action is requested.

Claims 10 and 11 have been rejected under 35 U.S.C. § 103 as being unpatentable over Kijowski in view of Ito. Applicants have cancelled claims 10 and 11 without prejudice to the filing of a divisional application directed to the subject matter of those cancelled claims.

Appln. No.: 10/075,378  
Amendment dated November 13, 2003  
Reply to Office Action of July 16, 2003

For all of the above-disclosed reasons, claims 1 to 9 are allowable. A notice to this effect is earnestly solicited at the earliest convenience. If any issues remain, the Examiner is invited to contact the undersigned at 202-508-9248.

Respectfully submitted,

Brian E. Hanlon  
Brian E. Hanlon  
Registration No. 40,449

Banner & Witcoff, Ltd.  
1001 G. Street, N.W.  
Eleventh Floor  
Washington, D.C. 20001-4597  
Telephone: (202) 824-3248  
Dated: November 13, 2003